

I. REMARKS

Claims 17 to 36 and 38 to 48 are be pending.

Regarding the prior art rejection

Applicants gratefully acknowledge the withdrawal of the anticipation rejections based on Kenney et al. and Miyachi et al. Applicants also gratefully acknowledge the withdrawal of the indefiniteness rejection.

1. Girten et al.

The only rejection of the claims remaining is the anticipation rejection of claims 17 to 22, 25, 35, 36, 38 to 40 and 42 to 45 based on Girten et al. (U.S. Pat. No. 6,284,735; hereinafter the '735 patent). Applicants respectfully traverse the rejection.

The Action alleges that the declaration filed by Applicants in September of 2002 fails to antedate the '735 patent because: (1) all inventors did not sign the declaration; (2) there was no averment that the invention was made in the United States; and (3) citing MPEP 715.03 Section B, the declaration did not make a showing that Applicants completed all of the species shown in the '735 patent.

In response, attached hereto is a new Declaration signed by all of the inventors showing that the subject

invention antedates the '735 reference. Specifically, the attached Declaration asserts that the subject invention was conceived and reduced to practice several months prior to the filing date of the Girten patent. See paragraph 6 of the Declaration.

In further support of this contention, attached to the Declaration is a copy of a memorandum from Yazhong Pei and Hengyuan Lang, the inventors of the subject application. The memorandum is dated December 21, 1998. The memorandum states that "TRG 4500," which is the designation of the combinatorial library exemplified in the subject application, and whose reaction scheme and resulting compounds are the basis of the subject invention, was already completed by that date. See paragraph 7 of the Declaration.

Also attached to this memorandum, and enclosed herewith, is a list of the building blocks used to make the subject combinatorial library. As the Declaration documents, the combinatorial library referred to in the attached memorandum is precisely the same as the one described in the examples of the subject application. Specifically, all of the building blocks listed in the attached memorandum and used to make the subject combinatorial library are precisely the same ones at the same positions as those described in the examples of the subject application. See paragraphs 8 to 10 of the Declaration.

Applicants also note that the earliest filing date of the Girten patent that discloses any benzimidazole derivatives is July 16, 1999. Any earlier filed patent application to which the Girten patent claims priority discloses no such subject matter. See paragraphs 2 to 4 of the Declaration.

Secondly, the Declaration asserts that the subject invention was made in the United States. See paragraph 11 of the Declaration.

Finally, citing MPEP 715.03 Section B, the Action alleges that, to antedate the '735 patent, Applicants must show that they completed all of the species shown in the patent before the date the patent was filed.

In response, Applicants respectfully submit that there is another way of antedating the '735 patent. Specifically, MPEP 715.03 Section B also states that: "the applicant may be able to antedate the reference indirectly by, for example, showing prior completion of one or more species which put him or her in possession of the claimed genus prior to the reference date."

In the attached declaration (and in the declaration previously filed) Applicants have shown precisely what this portion of MPEP 715.03 Section B requires. Specifically, Applicants have shown that they were in possession of numerous species prior to the

relevant priority date of the '735 patent. Moreover, these species put Applicants in possession of the claimed genus.

In an interview with the Examiner on November 5, 2003, the Examiner agreed with this assessment. Applicants thank the Examiner for her prompt review and assessment of this issue. Accordingly, Applicants respectfully request that this rejection be withdrawn.

In sum, because the date of the subject invention is prior to the 102(e) date of the '735 patent and because Applicants were in possession of the claimed genus prior to the date of the '735 patent, this cited reference fails to anticipate the subject claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

III. CONCLUSION

In light of the Remarks made herein, Applicants respectfully submit that the claims are now in condition for allowance and request a notice to this effect. Should the Examiner have any questions, she is invited to call the undersigned attorney.

Respectfully submitted,

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